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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,098	09/22/2003	Shelton L. Palmer	54317-011905	2929

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EXAMINER

BAROT, BHARAT

ART UNIT PAPER NUMBER

2155

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/668,098

Applicant(s)

PALMER ET AL.

Examiner

Bharat N Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 43-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/25/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 43-47 are presented for examination.

#### Reissue Formalities

2. The original patent appears to have been printed with additional errors not corrected by the certificate of correction. Col. 5, lines 33-34, "in" and "synchronously" appear to be at odds. Col. 5, line 51, "ULR" is a typographical error. Col. 8, line 6, "a" is a typographical error. Applicants are requested to correct these problems from the original patent in accordance with MPEP § 1453.
3. To date, applicants' amendments to the claims have not been compliant with 37 CFR § 1.173 (c) in that applicants' have made amendments without an explanation of the support in the disclosure of the patent for the changes made to the claims on a separate page. Future amendments should comply with this rule.

#### Oath/Declaration

4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error that is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and see MPEP § 1414.
5. Applicants' declaration did not identify at least one *proper* error other than one related to a matter of recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. However, this error has been held to be improper and therefore, applicants' declaration remains defective until a proper error is identified.

6. Applicants are advised that they must submit a complete and proper reissue declaration to correct the problem noted above.

7. Claims 43-47 are rejected as being based upon a defective reissue declaration, under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

#### **Abstract**

8. The abstract of the disclosure is objected to because the abstract does not accurately reflect the wide-ranging scope of applicants' current claims. Correction is required. See MPEP § 608.01(b).

#### **Specification**

9. The attempt to incorporate subject matter into this application by reference to the provisional application 60/008,111 is improper because applicants are attempting to incorporate essential material necessary to describe the claimed invention of the instant application. As applicants are attempting to incorporate by reference at Col. 8, lines 33-34 of USP 5,905,865 with a mere reference to the provisional application, such reference "is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 USC § 112, 1<sup>st</sup> paragraph." *In re Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973) and MPEP § 608.01(p). Since the referenced application has not been published, applicants "are required to amend the disclosure of the instant application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or

declaration executed by the applicant(s), or a practitioner representing the applicant(s), stating the amendatory material consists of the same material incorporated by reference in the referencing application.” (See MPEP § 608.01(b) (1).)

10. The specification is objected to because of the following informalities:

- a. The reissue application is a divisional of the copending reissue application 09/860,259. The cross-reference information is missing on the first page of the specification. (See 37 CFR 1.177 (a))
- b. Applicant files more than one application for the reissue of a single patent. The claims of the original patent are missing. (See 37 CFR 1.177 (b))

Appropriate corrections are required.

#### **Claim Objections**

11. Claim 47 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 47 is depend on canceled claim 39 and contain limitations “the internet content provider” and “the internet telephone” which are failing to further limit the subject matter of a previous claim.

12. Claim 44 and 47 are objected to because of the following informalities: Claims 44 and 47 contain “internet” which is typographical error. Appropriate corrections are required.

**Claim Rejections - 35 USC § 112, 2d paragraph**

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 45 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "relative synchronicity " in claim 45 is a relative term that renders the claim indefinite. The term "relative synchronicity" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. It is unclear what level of precision is called for to meet applicants claim limitations.

Claim 47 recites the limitation "the internet content provider of the site" in line 2. There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 U.S.C. § 102**

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claim Rejections - 35 U.S.C. § 102**

15. Claims 43-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Throckmorton et al, patent no. 5,818,441.

<p>43. A method of selling an offering through a broadcast and online system comprising the steps of:</p> <p>transmitting a broadcast programming the broadcast programming containing commercial programming, and the programming being selectively a television program;</p> <p>transmitting an Internet address wherein the Internet address specifies a web site corresponding to the commercial programming; permitting retrieval of the website; and</p> <p>providing a chat area related to the site whereby a user can communicate and chat with a salesperson over the Internet about an offering corresponding with the commercial programming.</p>	<p>Throckmorton et al teaches a method of selling an offering through a broadcast and online system <u>[column 3 lines 35-66 and column 9 lines 1-25]</u>.</p> <p>transmitting broadcast programming <u>[2, figure 1 and 30, figures 2 and 4]</u>, the broadcast programming containing television programming <u>[column 4 lines 6-20 and column 5 line 65 to column 6 line 20]</u>; and also teaches that the broadcast programming containing commercial programming <u>[column 3 lines 42-49]</u>.</p> <p>transmitting an Internet address (URL), wherein the Internet address specifies a web site corresponding to the commercial programming <u>[column 8 line 53 to column 9 line 22]</u> and permitting retrieval of the website <u>[column 7 lines 41-45 and column 8 lines 15-24]</u>.</p> <p>providing a chat area related to the site whereby a user can communicate and chat with a salesperson over the Internet about an offering corresponding with the commercial programming <u>[column 3 lines 42-49 and column 9 lines 1-14]</u>.</p>
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Art Unit: 2155

44. A method as claimed in claim 43 wherein the Internet address is directly transmitted separately from the broadcast.

Throckmorton et al teaches that the Internet address is directly transmitted separately from the broadcast [figure 1 and column 4 lines 1-20].

Throckmorton et al explicitly teaches that the associate data, the URL [column 9 line 4] can be transmitted using different types of delivery medium including telephone network [column 4 lines 16-19]. When the primary data stream and the associated data are delivered by the broadcast television and the telephone network respectively, the television station, which has both the primary data stream and associate data and no access to the telephone network, has to transmit the associate data, the URL, to another facility which has access to the telephone network for retransmitting the URL to the user computer.

In summary, Throckmorton et al implicitly teaches the address transmitter when the system uses two completely different types of delivery medium to deliver the primary data stream and the associated data, the URL.



<p>45. A method as claimed in claim 43 wherein the website is displayed by a user in relative synchronicity with the programming.</p>	<p>Throckmorton et al teaches that the website is displayed by a user in relative synchronicity with the programming <u>[column 7 lines 41-45]</u>.</p> <p>The web page associated with the URL is intended to enhance the utility of the primary data stream <u>[column 3 lines 59-60]</u>. As such, the associate data transmission facility and the television station, inherently, transmit the respective data simultaneously. In another embodiment, the URL [the associated data] is transmitted in the VBI of the primary data stream <u>[column 3 lines 55-60, column 5 lines 57-59, and column 7 lines 63-65]</u>. Therefore, it clearly shows the need of simultaneous transmission of the primary data stream and the associated data in all embodiments.</p>
<p>46. The method of claim 43 wherein the web site corresponding to the commercial programming offers information about a product or service advertised in the commercial programming to the consumer.</p>	<p>Throckmorton et al teaches that the web site corresponding to the commercial programming offers information about a product or service advertised in the commercial programming to the consumer <u>[column 3 lines 35-54 and column 9 lines 1-25]</u>.</p>
<p>47. The method of claim 39/43 including creating an internet telephone call between a user and the internet content provider of the site.</p>	<p>Throckmorton et al teaches that the creating an internet telephone call between a user and the internet content provider of the site <u>[column 6 line 64 to column 7 line 12 and column 8 lines 53-67]</u>.</p>

Art Unit: 2155

**Contact Information**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (571) 272-3978.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2155

December 07, 2004

*Bharat Barot*  
**BHARAT BAROT**  
**PRIMARY EXAMINER**

*MTA*  
*SPC*  
*AV 2155*